

In re: Aleksander Szlam
Filed: June 20, 2001
Serial No.: 09/885,717
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REMARKS

This is a complete response to the outstanding non-final Office Action mailed March 29, 2004. Claims 1, 6, and 7 have been amended herein. Claims 13 - 16 have been canceled herein. No new matter has been added to the currently pending claims. Support for amended claim 1 can be found in canceled claim 16. Upon entry of this response, claims 1-12 and 17-39 remain pending in the present application.

The Office Action asserts a preliminary rejection of pending claims 2, 6-7, and 25 based upon the second paragraph of 35 U.S.C. § 112. The Office Action asserts a preliminary rejection of pending claims 1, 3-4, 9-10, 12-14, 19, 23, and 28 based on anticipation under 35 U.S.C. § 102(e). The Office Action asserts a preliminary rejection of pending claims 2, 5-8, 11, 15, 17, 20-22, 24, 26, 29-32, 34, 36, 38-39 based on obviousness under 35 U.S.C. § 103. Claims 16, 18, 25, 27, 33, and 35 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The Applicants traverse all of the rejections of the Office Action. Applicants appreciate the Examiner's review of the above-identified patent application and respectfully request reconsideration and allowance

in view of the above amendments and following remarks.

I. Response to Claim Rejection -35 USC § 112

Claim 2 has been amended to recite "a saved customer profile" to provide proper antecedent basis.

Claim 6 recites the limitation "a message" in lines 7 and 8, which provides proper antecedent basis for "said message" in line 9.

Claim 7 recites the limitation "a message" in lines 7 and 8, which provides proper antecedent basis for "said message" in line 9.

Claim 25 has been amended to recite "multiple incidences" to provide proper antecedent basis.

II. Response to Claim Rejections Based on Anticipation

In the Office Action, claims 1, 3-4, 9-10, 12-14, 19, 23, and 28 have been preliminarily rejected as anticipated under 35 U.S.C. § 102(e). Specifically claims 1, 3-4, 9-10, 12-14, 19, 23, and 28 have been rejected under 35 U.S.C. § 102(e) by U.S. Patent 6,256,620 to Jawahar (hereinafter, "Jawahar").

A. Claim 1

Applicant has amended claim 1 to include allowable subject matter of original dependent claim 16. In the office action the Examiner acknowledged that claim 1 would be allowable if rewritten in independent form including all of the limitations of the base claim. See section 17 of the Office Action dated 3/29/04. For at least this reason, the claim rejection of anticipation should be withdrawn and claim 1 should be allowed as amended.

B. Claims 2 - 12 and 17 - 22

The Applicant respectfully submits that since claims 2 - 12 and 17 - 22 depend on independent claim 1, claims 2 - 12 and 17 - 22 contain all limitations of independent claim 1. Since independent claim 1 should be allowed, as argued herein, pending dependent claims 2 - 12 and 17 - 22 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 23

Independent claim 23 reads:

A method for providing assistance to a customer at a web

site, comprising the steps of: receiving a request for a web page from a customer; **determining whether a customer service representative is available**; if a said customer service representative is available **then sending said web page to said customer with a HELP option** on said web page.

(Emphasis Added)

The Applicant respectfully submits that the reference Jawahar fails to disclose, teach, or suggest all of the above-emphasized elements of claim 23. Specifically, Jawahar does not disclose **determining whether a customer service representative is available**. The Examiner seems to attempt to make connections and draw conclusions based on what the Examiner deems to be inherent or common sense. Recently, Judge Newman, in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430 (Fed Cir. 2002), repeated a fundamental principle that an Examiner cannot simply rely upon "common knowledge" or "common sense" (even when couched in terms of "Official Notice"):

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated ... The Board's findings must extend to all material facts and must be **documented on the record**, lest the "haze of so-called expertise" acquire insulation from accountability. **"Common knowledge and common sense", even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.** *Id.*

Official Notice is not a citation, and is not a tool of rejection. Rather, Official Notice is a doctrine an Examiner can invoke, *at the request of the Applicant*, to avoid the need to prove-up various matters to which both the Examiner and the Applicant agree are well known. This is not the case here. Thus, the Examiner is misusing the doctrine of Official Notice, and any rejections or motivations for combinations based thereon is unauthorized by the Applicant and should be withdrawn.

The Office Action cites to column 7, lines 15-20 of Jawahar, however, this does not disclose the above emphasized elements. The Office Action then uses hindsight based on Applicant's disclosure to produce Applicant's claimed invention. Jawahar does not disclose determining if a customer service representative is available to help a customer. Jawahar assumes an agent is available and merely identifies the one or more available agents.

Jawahar specifically states, "Control server 64 communicates with transaction processing system 42 to locate **one or more** available agents and customers." The Office Action misinterprets Jawahar to read the control server as identifying whether an agent is available. The Office Action then uses this misinterpretation

with hindsight based on Applicant's disclosure to imply that Jawahar would not transmit the help button if no agents were available. Nowhere does Jawahar disclose, teach or suggest not sending the help button based on the agent being unavailable. Therefore Jawahar does not disclose the above-emphasized elements of claim 23 and the anticipation rejection should be withdrawn.

D. Claims 24 - 31

The Applicant respectfully submits that since claims 24 - 31 depend on independent claim 23, claims 24 - 31 contain all limitations of independent claim 23. Since independent claim 23 should be allowed, as argued herein, pending dependent claims 24 - 31 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

III. Response to Claim Rejections Based on Obviousness

In the Office Action, claim 32 has been preliminarily rejected as obvious under 35 U.S.C. § 103. Specifically claim 32 has been rejected under 35 U.S.C. § 103 by U.S. Patent No. 6,256,620 to Jawahar (hereinafter, "Jawahar") in view of U.S. patent No. 5,185,782 to Srinivasan (hereinafter, "Srinivasan").

A. Claim 32

Independent claim 32 reads:

A method for providing assistance to a customer at a web site, comprising the steps of: receiving a request for a web page from a customer; **determining whether a customer service representative is available**; determining an estimated time before a customer service representative will be available; and **if said estimated time is less than a predetermined time then sending said web page to said customer with a HELP option on said web page.**

(Emphasis Added)

The Applicant respectfully submits that the reference Jawahar in view of Srinivasan fails to disclose, teach, or suggest all of the above-emphasized elements of claim 32. Specifically, Jawahar does not disclose **determining whether a customer service representative is available**. As previously discussed in greater detail with regard to claim 32, the Office Action is misusing the doctrine of Official Notice, and any rejections or motivations for combinations based thereon is unauthorized by the Applicant and should be withdrawn. The Office Action then applies hindsight based on Applicant's disclosure to produce Applicant's claimed invention. Jawahar does not disclose determining if a customer service representative is available to help a customer. Nowhere does Jawahar disclose, teach or suggest not sending the help

button based on the agent being unavailable.

Srinivasan does not cure this defect. In fact, Srinivasan teaches away from not sending the help button based on agents being unavailable. Srinivasan discloses placing the call in a queue if no agent is available, until an agent becomes available.

See Srinivasan column 4, lines 35-40. Nowhere in Srinivasan is disclosed, taught or suggested not sending help based on the agent being unavailable. Even if one were to combine the references, which Applicant does not concede, the combination would suggest sending the help button and placing the customer help request in a queue.

Even when the hold time is expected to exceed a predetermined limit, Srinivasan discloses retrieving information to allow the agent to call back. See Srinivasa column 4, lines 55-70. This does not teach or suggest that Jawahar should not send the help button based on the agent being unavailable and in fact teaches away from not sending the help button. Therefore Jawahar in view of Srinivasan does not disclose the above-emphasized elements of claim 32 and the anticipation rejection should be withdrawn.

The Applicant respectfully submits that since claims 33 - 39 depend on independent claim 32, claims 33 - 39 contain all limitations of independent claim 32. Since independent claim 32 should be allowed, as argued herein, pending dependent claims 33 - 39 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

IV. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 1-12 and 17-39 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited

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to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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